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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,473	02/01/2001	Adrian P. Wise	100417(EP)USD1X1C1D6 PDD	4618

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DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
2355 MAIN STREET, SUITE 200
IRVINE, CA 92614

EXAMINER

NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 04/25/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

PRE

Office Action Summary

Application No.

09/773,473

Applicant(s)

WISE ET AL.

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1 – 13 are considered for examination.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It is claiming the domestic priority of application 08/382952 which is not the same application as mentioned in the disclosure as 08/382958.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of patent No. 6263422

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[hereinafter '422 patent]. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

As per claims 1-7, the '422 patent contains the subject matter claimed in the instant application. As per claims 1-7, both are claiming common subject matter, as follows:

A decoder comprising:

processing stages interconnected ...;and

wherein the tokens provide ...

The claims of '422 patent does not specifically state the standard-dependent and standard-independent stages as described in the claims 1-7 of instant application but it would have been obvious to a person skill in the art to recognize that the two claims are similar because all of the stages and selected stages of claims 1-7 in '422 patent perform the same functions as the claims of instant application.

As per claims 8-13, they are also directed to the same subject matter recited in claims 1-7 above. Accordingly, they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

Specification

5. Examiner request Applicants to update the status of any related applications as mentioned in the disclosure.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Horvath et al. [US Patent No 5450599].

8. As per claim 1, Horvath discloses the invention as claimed including a multi-standard decoder for decoding a data stream comprising:

processing stages interconnected to form a pipeline [Abstract] and for processing tokens [blocks] derived from the data stream [col 7, lines 63-col 8, lines 2],

the processing stages including standard-independent [col 6, lines 12-14; and col 8, lines 3-24] and standard-dependent processing stages [Abstract; and col 3, lines 63-col 4, lines 12], wherein the standard-dependent processing stages capable of reconfiguration to operate in accordance with different data encoding standards [col 1, line 33-41, and col 5, line 15-30]; and

wherein the tokens provide reconfiguration information to the standard-dependent processing stages [col 1, lines 33-51].

9. As per claim 2, Horvath discloses each of the tokens includes an extension indicator that indicates whether additional words are present [col 5, lines 24-30; and col 8, lines 24-27].

10. As per claim 3, Horvath discloses one of the standard-dependent processing stages comprises an inverse quantizer [Figure 4].

11. As per claim 4, Horvath discloses one of the tokens comprises a first QUANT_TABLE token [col 9, line 32-46].

12. As per claim 5, Horvath discloses the inverse quantizer recognizes the first QUANT_TABLE token [col 7, line 7-13] and, responsive to a first state of the extension indicator in a first word of the first QUANT_TABLE token, generate a second QUANT_TABLE token to be conveyed to another of the processing stages [col 9, line 55-col 10, lines 9].

13. As per claim 6, Horvath discloses the second QUANT_TABLE token includes quantization table values [col 3, line 64-col 4, lines 3].

14. As per claim 7, Horvath discloses responsive to a second state of the extension indicator of the first word of the QUANT_TABLE token, the inverse quantizer installs a quantization table of the first QUANT_TABLE token in a memory [col 7, line 7-13].

15. As per claim 8, it is method claimed of claim 1, it is rejected for similar reasons as stated above in claim 1.

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16. As per claim 9, it is rejected for similar reason as stated above in claim 2. Furthermore, Horvath discloses the states to indicate reconfiguration information [col 2, lines 45-55].

17. As per claim 10, it is method claimed of claims 4 and 5, it is rejected for similar reasons as stated above in claims 4 and 5.

18. As per claim 11, it is rejected for similar reason as stated above as in claim 6. Furthermore, Horvath discloses quantization table values to be used by the another processor [col 5, line 41-48].

19. As per claim 12, it is rejected for similar reason as stated above in claim 7.

20. As per claim 13, it is rejected for similar reasons as stated above as in claim 1.

21. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on Monday – Friday (8:00 – 5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703) 308-9678.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directly to the receptionist whose telephone number is (703) 305-3900.

Dustin Nguyen



VIET D. VU
PRIMARY EXAMINER